

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) ESSR:062US	
I hereby certify that this correspondence is being electronically filed with the Patent and Trademark Office		Application Number 10/068,232	Filed February 6, 2002
on NOVEMBER 15, 2006		First Named Inventor Aude Prieur-Blanc	
Signature <u>Michael R. Krawzsenek</u>		Art Unit 1732	Examiner MATHIEU D. VARGOT
Typed or printed name <u>MICHAEL R. KRAWZSENEK</u>			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/06)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>51,898</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		<p><u>Michael R. Krawzsenek</u> Signature MICHAEL R. KRAWZSENEK Typed or printed name</p> <p><u>(512) 536-3020</u> Telephone number</p> <p><u>November 15, 2006</u> Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

I. The Negative Limitation “and not with a non-solvent” Is Supported by Applicant’s Specification

Independent claim 18 includes the following limitation: “wherein the fine grinding and/or the polishing comprises attacking the principal surface of the article with a solvent or a mixture of organic solvents and **not with a non-solvent** of the transparent thermoplastic material” (emphasis added). Contrary to the Examiner’s assertion, Applicant’s specification supports this limitation and satisfies the written description requirement of 35 U.S.C. §112, first paragraph.

A. The Examiner Contradicts Settled Patent Law and Applies a Subjective Standard

It is well-settled that “[i]f alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.” MPEP § 2173.05(i) (case citations omitted). Stated another way, if Applicant’s specification recites an alternative element (*i.e.*, “and not with a non-solvent”), that element can be explicitly excluded from the claims. *Id.*

The Examiner appears to disregard the law on negative limitations by creating his own subjective standard. For instance, in rejecting the claims for lack of written description, the Examiner argues that “**while applicant admittedly has support** for the mixture of solvents to contain a non-solvent (page 5, lines 1-5) this would appear to be more an afterthought based on the disclosure of the admitted prior art...rather than an alternative embodiment.” June 15, 2006 Final Office Action at 2 (emphasis added). The Examiner continues his analysis by stating:

While there may be case law to allow alternative embodiments to be expressly excluded from the claims, it is respectfully submitted that the instant disclosure of using a non-solvent does not rise to the level of an alternative embodiment, at least one that would be excluded from the claims.

Id. at 3. The Examiner concludes by declaring that “[i]f [the claim language “not with a non-solvent”] were really an alternative embodiment, then certainly some example would have been disclosed using such an embodiment.” *Id.*

In summary, the Examiner appears to suggest some hierarchy in which explicit statements in the specification may be: (1) afterthoughts; (2) alternative embodiments that may not be excluded from claims; or (3) alternative embodiments that may be excluded from claims. The suggested hierarchy finds no support in the MPEP, rules, or statutes. The only suggestion of any objective analysis in the Examiner’s standard (requiring a working Example for any alternative embodiments) is also not supported with a single authority.

B. The Specification Provides Written Support for “and not with a non-solvent”

The Examiner inappropriately applies his subjective standard to the following language which describes a non-limiting embodiment of the invention:

The solvent or mixture of solvents of the thermoplastic material to be treated may contain, in limited proportion, **up to 20% by weight**, preferably up to 15% by weight of an organic diluent which **is not a solvent** of the thermoplastic material to be treated. An example of such an organic diluent is ethylene glycol diacetate.

Specification at page 5, lines 1-4 (emphasis added). This passage clearly describes that a non-solvent can be used in alternative embodiments of the present invention. Therefore, Applicant’s specification provides written support for the claimed element “attacking the principal surface of the article with a solvent or a mixture of organic solvents and not with a non-solvent.” See MPEP § 2173.05(i) (“If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.”).

The above passage also demonstrates that other embodiments are contemplated where the polishing step is performed by a solvent or a mixture of organic solvents and not with a non-solvent. For example, the specification states that any non-solvents may comprise “up to 20% by

weight.” With no minimum percentage of non-solvents explicitly specified, the quoted language includes the range from 0% to 20%. Although the specification provides non-limiting alternatives (discussed above) and examples (discussed below) that support the contested limitation elsewhere, implicit support is also sufficient to satisfy the written description requirement of §112, first paragraph. *See* MPEP 2173.05(i) (“Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support.”) (citation omitted).

Unlike the Examiner’s apparent suggestion, MPEP 2173.05(i) places no minimum requirements on the number of words, sentences, or paragraphs that must be devoted to alternative elements positively recited in the specification. Consequently, Applicant’s positive recitation of alternative embodiments comprising non-solvents allows Applicant to explicitly exclude non-solvents in the claims.

C. The Specification Provides Support for “Pure” Solvents or Solvent Mixtures

Applicant’s specification explains that “pure” solvents or solvent mixtures can be used in non-limiting embodiments. For instance, the specification states:

In the attack step, the solvent or mixture of solvents is preferably pure, in other words it contains only the solvent or mixture of solvents and during the attack on the surface of the article, in particular a polycarbonate article, only the thermoplastic material of the article is dissolved in this solvent or these solvents.

Specification at page 5, lines 5-9 (emphasis added). This passage confirms that in one aspect, the attacking step can be performed with “only the solvent or mixture of solvents.” If the substance used in the attacking step contains only a solvent or mixture of solvents, then by definition it does not include a non-solvent. To conclude otherwise would defy logic, as well as basic tenets of the English language. The above-quoted language is yet another example of written support in the specification for the claim language “and not with a non-solvent.”

D. The Specification Provides Non-Limiting Working Examples That Use “Pure” Solvents or Solvent Mixtures

Applicant’s specification also provides non-limiting working examples that use a solvent or a mixture of solvents that are free of (*i.e.*, do not include) a non-solvent. For instance, “[c]onventionally ground, or ground and fine ground surfaces of polycarbonate lenses were subject to attacks according to the invention, under conditions detailed” in the “TABLE” on page 13 of the specification. Column 7 of this TABLE describes the types of solvents or solvent mixtures that were used. As illustrated in the TABLE, the solvents and solvent mixtures are free of non-solvents.

E. Summary of Conclusions

Applicant’s specification includes support for “and not with a non-solvent.” The specification provides explicit alternatives that can use: (i) non-solvents; or (ii) solvents or mixtures of solvents that are free of non-solvents. Further, there are twelve (12) non-limiting working examples that do not use non-solvents. For at least these reasons, the written description rejection is improper.

II. Claims 18-34 Are Not Obvious Because Duchane Teaches Nonsolvents Are Required for Smooth Surfaces

Claims 18-34 continue to be rejected under 35 U.S.C. § 103(a) as being obvious “over the admitted prior art as set forth at page 1, line 7 through page 2, line 11 of the instant specification in view of Duchane *et al.*...for reasons of record.” Final Office Action at 2-3. Applicant reiterates previous arguments provided in pages 7 through 12 of the Response filed April 3, 2006, as well as the following remarks.

In previously explaining the obviousness rejection in the Office Action dated October 3, 2005, the Examiner stated:

Whereas the prior art of Duchane et al which might only employ a solvent (as in the instant, allegedly) might not have perfectly smooth surfaces at this magnification, it is believed that one of ordinary skill in the art would understand from this disclosure that the surfaces treated with only a solvent would have macroscopically smooth surfaces. It is submitted that these macroscopically smooth surfaces would be the instant smooth surfaces.

Office Action dated October 3, 2005 at 3.

In actuality, Duchane teaches that surfaces treated with only a solvent do not obtain a smooth surface, either macroscopically or microscopically. In addition to the supporting statements previously submitted, Applicant notes that Duchane teaches “[i]f a smooth surface is to be obtained, the nature of the nonsolvent component must be such that it does not separate out into significant agglomerations, bubbles, or the like[.]” Duchane, col. 5, lines 56-58 (emphasis added). The reference further states “[t]he bath consists essentially of at least one solvent and at least one nonsolvent” and “the starting solution must consist of a bath consisting of a solvent...and a non-solvent.” *Id.* at col. 5, lines 36-37 and col. 6, lines 12-15 (emphasis added). Clearly, Duchane teaches that a non-solvent is needed to obtain a smooth surface (with no distinction for macroscopically or microscopically smooth surfaces).

Notwithstanding the Examiner’s assertions to the contrary, one of ordinary skill in the art would not understand from this disclosure that the surfaces treated with only a solvent would have macroscopically smooth surfaces because the reference explicitly states otherwise. As a result, claims 18-34 are not obvious over the “admitted prior art” in view of Duchane.

III. Conclusion

For at least the foregoing reasons, the written description and obviousness rejections to claims 18-34 should be withdrawn, and the claims should be allowed.